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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,869	07/22/2003	Theodore G. Duclos	99-0033/COA	7658

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FREUDENBERG-NOK GENERAL PARTNERSHIP
LEGAL DEPARTMENT
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER

KYLE, MICHAEL J

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,869	Applicant(s) DUCLOS ET AL.	
	Examiner Michael J. Kyle	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-25 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7-11, 14, 15, 17-19, 21, 22, 24, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey (U.S. Patent No. 3,033,582) in view of Udagawa (U.S. Patent No. 6,186,513). With respect to claims 1, 7, 10, 17, 18, 22, and 25, Creavey discloses a static gasket sealing between first (21) and second (20) sealing surfaces that are secured together. Creavey also discloses a generally flat carrier member (11) having a generally planar top surface, a first stopper member (15), second stopper member (16), a cavity formed between the stopper members, and the stopper members having a height above the top surface of the carrier member. The second stopper member (17) has a height greater than that of the first stopper member (16). Creavey further discloses an elastomeric seal member (17) inside the cavity, having a sealing bead with an apex greater than the height of the first and second stoppers. The apex is adapted to compress to the height of the first and second stoppers as (shown in figures 3-5), where the stoppers prevent the seal member (17) from being over compressed. Creavey further discloses a second pair of stoppers on an opposite surface (bottom portion of gasket, mirror image stoppers 16, 17), where the stoppers have a height above the opposite surface. Additionally, Creavey shows a second elastomeric sealing member (mirror of 17, bottom portion of gasket in figures 3-5). The second pair of stoppers limits the compression of the second elastomeric sealing

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members. Creavey shows the first and second stoppers formed integrally, not independently from the carrier member.

3. Udagawa teaches a gasket assembly where a stopper member may be formed either integrally (E12 in figure 6) or independently (F12 in figure 4) from a carrier member (E or F). From this Udagawa shows that stoppers formed integrally and independently of base members are equivalent and interchangeable within the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the stoppers of Creavey either integral or independent from the carrier member, as these are equivalent ways of including stoppers in a gasket arrangement.

4. Examiner notes that there are several limitations regarding a method of loading the gasket, or an intended use of the gasket, such as, "A clamp load is applied", and the gasket is "subjected to the clamp load". It is noted that Creavey discloses all of the claimed structural elements, and is capable of being loaded as claimed by applicant. It is further noted that the reactive forces from the surfaces 20 and 21 of Creavey are identical to the forces that would arise from the clamping forces recited in the claims. Furthermore, the claims are drawn only to the gasket itself. Creavey meets all of the structural limitations of the gasket.

5. With respect to claims 2-4, Creavey discloses the sealing bead to be a triangle, the volume of the cavity is greater than the volume of the elastomeric seal member, and the elastomeric seal member is formed from a fluorocarbon. U.S. Patent No. 4,460,155 to Smith is cited as an evidentiary reference to show that Teflon (used by Creavey) is a fluorocarbon.

Examiner cites Smith column 3, lines 32-34 to show this.

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6. With respect to claims 8, 9, and 21, Creavey discloses the first and second stopper members (16, 17) are metal, and the apex is compressed 1.5% to 70%.

7. With respect to claims 11 and 19, examiner notes these appear to be a product-by-process claim, where a process of making the product is claimed, in a product claim. Claims 11 and 19 are product claims. As such, only the physical structure of the claim is considered. Any prior art reference that meets the structural limitations is considered to be capable of being made in the claimed manor. Examiner asserts that the elastomeric sealing members of Creavey are capable of being formed from any of the claimed cure systems, and the first stopper member is capable of being molded on the carrier.

8. With respect to claim 14, Creavey's carrier (11) is made of metal.

9. With respect to claims 15 and 24, Creavey does not explicitly disclose the stopper members to have a shape factor between .15 and 10. However, since there is no showing of criticality of the recited range, such recited range would have been obvious to one of ordinary skill in the art. Altering the shape factor of an element is considered to a design choice within the skill of the art.

10. Claims 17 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent No. 2,513,178) in view of Udagawa. Jackson discloses a static gasket sealing between first and second sealing surfaces comprising a generally flat carrier (portion between seals 13, in figure 5) with generally planar first surface and a second surface facing the respective sealing surfaces, and a first stopper member (raised portion to left of 13, in figure 5) with a first height. Jackson further discloses an elastomeric seal (13) formed on the first surface

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with a height greater than the first height. The elastomeric seal (13) has a thickness greater than that of the carrier. Jackson shows the first stopper formed integrally, not independently from the carrier member.

11. Udagawa teaches a gasket assembly where a stopper member may be formed either integrally (E12 in figure 6) or independently (F12 in figure 4) from a carrier member (E or F). From this Udagawa shows that stoppers formed integrally and independently of base members are equivalent and interchangeable within the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the stoppers of Creavey either integral or independent from the carrier member, as these are equivalent ways of including stoppers in a gasket arrangement.

12. Claims 5, 6, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view of Udagawa, as applied to claims 1, 10, and 17 above, and further in view of Combet et al ("Combet", U.S. Patent No. 6,390,479). Creavey and Udagawa are silent with regard to the dimensions of the carrier member.

13. Combet teaches a carrier member having a thickness of less than 1.0 mm and the compressed thickness is in the range of 0.015 and 1.75 mm (column 3, line 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to change the thickness of the prior art carrier since such a modification is a design consideration within the skill of the art. In re Rose, 220 F.2d, 105 USPQ 237 (CCPA 1955).

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14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Creavey in view Udagawa, as applied to claim 17 above, and further in view of Lucas et al ("Lucas", U.S. Patent No. 4,635,949). Creavey and Udagawa fail to disclose an adhesive layer on the second surface of the carrier member.

15. Lucas teaches a gasket assembly where a seal ring (8) is bonded to the carrier, or sheet, (1) by a heat resistant adhesive. The adhesive positively secures the seal (8) to the carrier (1). It would have been obvious to one having ordinary skill in the art at the time of the invention to positively secure the seal (17) to the carrier member (11) of Creavey. This results in an adhesive layer on the second surface of Creavey.

Response to Arguments

16. Applicant's arguments filed May 30, 2006, have been fully considered but they are not persuasive. Applicant argues that Creavey and Jackson do not show a generally flat carrier having a generally planer top surface. Examiner respectfully disagrees. Examiner notes that the carriers in both Creavey and Jackson have a planar top portion that abuts against the member being sealed against. Additionally, the carriers are generally flat, even with the stopper portions integrally formed thereon. Further, if modified as taught by Udagawa, the stopper members may be formed separately. In this situation, a flat carrier with a planar top surface is also seen.

17. Applicant argues that impermissible hindsight reconstruction was used in the rejection above. Examiner respectfully disagrees. The suggestion for combining Creavey or Jackson with Udagawa comes from Udagawa's disclosure that forming stoppers integrally with, or independently of a carrier member are equivalent means of forming stoppers. One of ordinary

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skill, looking at the prior art reference of Udagawa would recognize that stoppers be formed either way to arrive at the same result.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

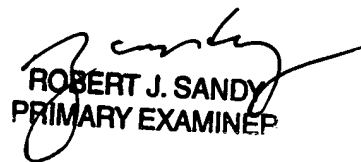
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mk


ROBERT J. SANDY
PRIMARY EXAMINER